

Remarks/Arguments

The foregoing amendments to the claims are of a formal nature, and do not add new matter. Claims 119-126, 129-131 and 135-142 were pending in this application and were rejected on various grounds. Claims 119-123 are canceled without prejudice or disclaimer. Thus, Claims 124-126, 129-131 and 135-142 are now pending in this application. The rejections to the presently pending claims are respectfully traversed.

Claim Objections

The syntax of claims 140-142 was objected to and has been amended to replace the term "above" with "greater" and thus this objection should be withdrawn.

Claim Rejections - 35 USC § 112, first paragraph-enablement

C. Claims 119-123 and 139-142 remain rejected under 35 U.S.C. §112, first paragraph because the specification, while being enabling for SEQ ID NO: 325 and 326, does not reasonably provide enablement for polynucleotides or polypeptides having at least 80%, 85%, 90%, 95% or 99% sequence identity to SEQ ID NO: 325 or 326, to the protein encoded by ATCC No. 203129 or for vectors and host cells containing these polynucleotides.

Without acquiescing to the propriety of this rejection, Applicants have canceled claims 119-123 and hence this rejection is moot with respect to these claims.

Claims 139-142 have been amended to recite "an isolated nucleic acid molecule consisting of at least a 20 nucleotide fragment of the nucleic acid sequence of SEQ ID NO: 326 or a complement thereof that specifically hybridizes under stringent conditions." Support for the hybridization language is found from page 312 onwards ("Stringent conditions"), especially on page 313, lines 1- 5 and support for the PCR probes or primers of the lengths are found on page 285, line 11 onwards of the instant specification. One of skill in the art would know exactly how to use these PCR primers and probes for the diagnosis of colon tumors, especially in view of the gene amplification assay disclosed on page 539, Example 170. Therefore, the amended Claims 139-142 are not broad and are well supported by the instant disclosure. Accordingly, Applicants request that this rejection be withdrawn.

Claim Rejections - 35 USC § 112, first paragraph-written description

Claims 139-142 remain rejected under 35 U.S.C. 112, first paragraph because, according to the Examiner, "no arguments regarding the functional limitation "primers or probes" have been provided, and further, these are genus claims."

Claims 139-142 are further rejected under 35 U.S.C. 112, first paragraph (new matter) allegedly for reciting hybridization conditions not found in the specification as originally filed and for reciting PCR primers or probes of lengths not found in the specification. Applicants respectfully traverse this rejection.

As noted before, whether the Applicants were in possession of the invention as of the effective filing date of an application is a factual determination, reached by the consideration of a number of factors, including the level of knowledge and skill in the art, and the teaching provided by the specification. The inventor is not required to describe every single detail of his/her invention. An Applicant's disclosure obligation varies according to the art to which the invention pertains.

Claims 139-142 have been amended to recite "an isolated nucleic acid molecule consisting of at least a 20 nucleotide fragment of the nucleic acid sequence of SEQ ID NO: 326 or a complement thereof that specifically hybridizes under stringent conditions." The teaching imparted in the specification must be evaluated through the eyes of a highly skilled artisan as of the date the invention was made. One of skill in the art would know exactly how to use these PCR primers and probes for the diagnosis of colon tumors, especially in view of the gene amplification assay disclosed on page 539, Example 170 and would know that Applicants had possession of probes that "consist of " nucleotide fragments of SEQ ID NO: 326 or a complement thereof, which is are well supported by the instant disclosure.

Hence, Applicants submit that this rejection should be withdrawn.

Claim Rejections – 35 USC § 112, second paragraph

Claims 139-142 are rejected under 35 U.S.C. §112, second paragraph for being indefinite. The Examiner says that the claims are confusing since it recites the nucleic acid of SEQ ID NO: 326 which is a polypeptide.

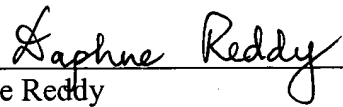
Applicants have amended this inadvertent error and claim 139 now recites SEQ ID NO: 325. Thus, dependent claims 140-142 are also definite. Accordingly, this rejection should be withdrawn.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No.: 39780-2730P1C60). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

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